



UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

NEW AGE PRODUCTS, INC.,
Plaintiff,
vs.
PROGRESSIVE INTERNATIONAL
CORP.,
Defendant.

CASE NO. 96-2129-J (CGA)

**ORDER INTERPRETING THE
PREAMBLES OF CLAIMS ONE
AND SIX OF THE PATENT-IN-
SUIT**

PROGRESSIVE INTERNATIONAL
CORP.,
Counterclaimant,
vs.
NEW AGE PRODUCTS, INC.
Counterclaim
Defendant.

This matter comes before the Court for Claim Interpretation. On January 29, 1998, this Court issued an Order stating that it would analyze whether the preambles in claims one and six would limit the patent to a sheet of plastic used as a cutting mat, as distinguished from a simple plain sheet of plastic. Additionally, the Court announced that it would determine whether the preambles in claims one and six should be construed as defining a plastic sheet having an upper size limit implied from the preamble language as well as

1 the explicit lower size limit specification the claims. (Jan. 29, 1998, Order). The Court
2 cautioned the parties that it would only consider intrinsic evidence.

3 For the reasons set forth below this Court finds that the preambles in claims one and
4 six limit the scope of the claims to a sheet of plastic used as a cutting and transferring board
5 for food, as distinguished from a simple plain sheet of plastic. Additionally, this Court finds
6 that the preambles in claims one and six should be construed as defining the sheet of plastic
7 used as a cutting and transferring board for food with an upper size limit of eleven inches in
8 width and fifteen inches in length, as well as the explicit lower size limits specified in the
9 claims.

10 I. Procedural History

11 This case involves the alleged infringement of U.S. Patent No. 5,472,790 (hereinafter
12 '790 Patent). New Age's ("Plaintiff") '790 Patent protects an invention entitled "Preparation
13 and Transfer Sheet," marketed as Chop & Chop, "The original flexible cutting mat." On
14 December 22, 1992, Plaintiff applied for the '790 Patent. The PTO reviewed and rejected
15 the application. On June 13, 1994, Plaintiff filed a second patent application, a continuation-
16 in-part application, ("CIP") to cure the defects in its first application. In support of its CIP
17 application, Plaintiff submitted declarations of patentability by inventor Roderick Thompson
18 and by Robert Casola, Jr., an alleged employee of one of Plaintiff's suppliers. On December
19 5, 1995, the '790 Patent was issued to Plaintiff. There are a total of nine claims in the '790
20 Patent, each claim reciting various physical parameters such as sheet thickness, Rockwell
21 hardness values, and flexural modules values.¹

22
23 ¹ The Pertinent claims are:

24 (1) Claim one states:

25 A flexible sheet for cutting and handling articles thereon, comprising:
26 a sheet of flexible resilient plastic material having lay-flat characteristics, a width
27 greater than 6 inches and a length greater than 10 inches;
28 said plastic material having a Rockwell hardness between 72 and 90;
said plastic material having a thickness between 0.008 inches and 0.060 inches;
said sheet having sufficient cantilever beam strength when flexed around the
longitudinal centerline and held proximate first end to support an article spaced at
least 10 inches from said first end and weighing at least 5 ounces.

(2) Claim six states: A flexible cutting sheet for food preparation, comprising:

1 On December 17, 1996, Plaintiff sued Progressive ("Defendant") for patent
2 infringement on the '790 Patent. Plaintiff asserts that Defendant infringed on claims one to
3 three, and five to nine of its '790 Patent-in-suit. On January 23, 1997, Defendant answered
4 and counterclaimed that the '790 Patent is invalid, unenforceable and not infringed for one or
5 more of the reasons alleged in its affirmative defenses.²

6 On February 10, 1997, Plaintiff filed its answer to Defendant's counterclaim. On May
7 5, 1997, Defendant filed its motion for leave to file its first amended answer and
8 counterclaim based on newly discovered facts and testimony derived through discovery. On
9 August 11, 1997, Defendant filed its supplemental motion to file its second amended answer.
10 On July 28, 1997, Plaintiff filed its motion for leave to amend its complaint. On August 19,
11 1997, Plaintiff filed a reply memorandum to Defendant's opposition. In its reply, aside from
12 contesting Defendant's arguments, it requested a further revision of the complaint. On
13 October 21, 1997, the Court granted both parties' motions to amend.

14 Plaintiff was given leave to: (1) delete claim one, two and five from its patent-in-suit,
15

16 a sheet of plastic sheet material having a thickness of less than .030 inches and a
17 flexural modulus in the range of 15 of 75,000 to 200,000 psi; said sheet having a
Rockwell hardness in excess of 72.

18 ² Defendant asserted the following affirmative defenses in its answer:
19 (1) Defendant does not infringe on any of the '790 Patent's claims (one to three and five to nine)
20 because the accused product does not fall within the recited parameters; (2) Plaintiff is estopped to
21 claim a construction for the '790 Patent that would allow the patent to cover any product made or
22 sold by Defendant; (3) the '790 Patent is invalid under 35 U.S.C. § 102 because the alleged invention
23 was on sale and described in printed publications more than one year before the patentee filed the
24 original application which matured into the '790 Patent; (4) the '790 Patent is invalid under 35
25 U.S.C. § 102 because the "invention" was known and used by others than the named inventor and
26 on sale before the "invention" of the accused product; (5) in light of the prior art at the time the
27 "invention" was made, the subject matter as claimed in the patent is not patentable under 35 U.S.C.
28 § 103 because it would have been obvious to a person skilled in the art to which the "invention"
relates; (6) the claims of the '790 Patent are invalid under 35 U.S.C. § 112 because each of them are
excessively vague, indefinite and do not distinctly define the invention; (7) the "invention" is invalid
under 35 U.S.C. § 102(g) because it was made by another in this country before the patentee's
product, and such person has not abandoned, suppressed, or concealed it; (8) Claim one of the '790
Patent is entitled only to the filing date of the continuation-in-part application and not the filing date
of the parent application because claim one of the continuation-in-part application contains a matter
not in the original parent application. Therefore, claim one of the '790 Patent is invalid under 35
U.S.C. § 102 because Plaintiff's product was on sale more than one year before the filing date of
Plaintiff's continuation-in-part application. Hence, the entire '790 Patent is then unenforceable
because this prior sale was withheld from the U.S. Patent and Trademark Office (PTO) with either
the intent to deceive or with gross negligence in breach of the patentee's duty of candor.

1 (2) add new party defendant Kevin Wold, and (3) add the new cause of action of inducing
2 infringement. Defendant was also allowed to add the following affirmative defenses: (1) the
3 '790 Patent is unenforceable because the Plaintiff and its attorney knowingly deceived and
4 breached their duty of candor to the PTO in filing the '790 Patent application when they: (a)
5 made representations about the physical parameters of the mat when they had conducted no
6 tests on the mat to determine said parameters, (b) filed a declaration with the PTO
7 representing that mat was not commercially available when it was, and (c) represented that
8 the inventor had discovered the mat's material characteristics when he did not; and (2) the
9 '790 Patent is invalid because the named inventor did not invent the mat.

10 On August 18, 1997, Plaintiff filed a memorandum in support of its motion for patent
11 claim interpretation which Defendant opposed. On October 6, 1997, the Court requested that
12 the parties brief the issue of whether claim interpretation was appropriate at this stage of the
13 litigation. The parties both then requested that the Court construe claims 1-9 of the patent-in-
14 suit. Specifically, the parties want the Court to determine whether the preambles in claims
15 one and six limit the patent to a sheet of plastic used as a cutting mat, as distinguished from a
16 simple plain sheet of plastic. Under Plaintiff's interpretation of the patent's language, the
17 claimed invention is a flexible cutting mat that improves upon prior flexible cutting mats by
18 employing a certain type of plastic sheet material. Under Defendant's interpretation, the
19 claimed invention is the plastic sheet material itself, which the named inventor did not
20 invent. Additionally, the parties want the Court to determine whether the preambles in
21 claims one and six should be construed as defining a plastic sheet having an upper size limit
22 implied from the preamble language, as well as the explicit lower size limit specified in the
23 claims.

24 II. Background

25 A. The Claims At Issue

26 A patent claim typically has three parts, the preamble, the transition and the body.
27 3 DONALDS CHISUM ON PATENTS § 8.06(b) at 8-99 (1997). The preamble, "is an
28 introductory phrase that may summarize the invention, its relation to the prior art, or its

1 intended use or properties." Id. The transition is a phrase connecting the preamble to the
2 body of the claim. Often the term 'comprising' is used in transition. "In the lexicon of patent
3 law, 'comprising' means that the 'recited elements are only a part of the device.' In other
4 words, if the invention is claimed as 'comprising' elements X and Y, it may also 'read on'
5 and cover a device with elements X, Y, and Z. The claim is thus 'open.'" Id. at § 8-100-01
6 (citations omitted).

7 The '790 patent has nine claims. (Complaint, '790 Patent ["Ex. A"]). Claims one and
8 six are independent and are the broadest in scope. Claims 2-5 depend from claim 1 so they
9 include any and all the limitations of claim one. Similarly claims 7-9 depend on claim 6 so
10 they all include limitations of claim 6.

11 The preamble of claim 1 recites: "A flexible sheet for cutting and handling articles
12 thereon, comprising . . ." (Pl.'s Mem., Ex. A at 33). The body of claim 1 recites a certain
13 combination of the properties of the plastic sheet, including its dimensions, thickness,
14 hardness, flexibility, cantilever beam strength, and lay-flat characteristics. The preamble of
15 claim 6 recites: "A flexible cutting sheet for food preparation, comprising . . ." (Pl.'s Mem.,
16 Ex. A at 54). The body of claim 6 again recites certain combination of properties of the
17 plastic sheet, including its thickness, flexibility, and hardness.

18 The dispute regarding the proper interpretation of the preamble is essential because,
19 "[i]f a preamble is a limitation it defines the scope of the claimed subject matter, it can be
20 relied on to distinguish the claims from the prior art. It can be relied on to avoid
21 infringement." CHISUM at § 8-108.

22 **B. The Parties' Briefs**

23 Plaintiff's Memorandum of Points and Authorities in support of its interpretation of
24 the '790 patent is clear and well organized. Plaintiff summarizes its position by explaining
25 that the issue is whether:

26 a claim directed to a certain article of manufacture was drafted in a manner that
27 unintentionally ensnares the very sheets of material from which the article is
28 made, not to mention other articles that may have been made from such
material. It is a matter of common sense and apparent to anyone that a flexible
cutting mat, such as those sold by the parties, and a sheet of plastic material
from which such a mat is die-cut, though structurally similar, are two different

1 things. The specification, claims and prosecution history show that the
2 patentee never intended to cast the net of patent protection so broad as to cover
the plastic material itself.
3 (Pl.'s Mem. at 1).

4 Plaintiff summarizes for the Court the three fundamental pieces of intrinsic evidence
5 that are used to construe the claims of the patent, including the language of the claims, the
6 specification of the patent, and the prosecution history of the patent. Plaintiff then analyzes
7 the evidence relevant to each of the three categories.,

8 Conversely the Court finds the Defendant's brief difficult to follow and not well
9 organized. The Defendant does not divide its discussion into the three types of evidence the
10 Court can consider. Rather Defendant moves around from one sub-argument to the next to
11 support its overall claim, and often makes conclusory statements.

12 The Defendant defines the issue as "whether the claims simply define a plain sheet of
13 plastic or whether the preamble of the claims requires that the claims be construed as limited
14 by the intended use of the plastic sheet as a cutting mat." (Def.'s Mem. at 2). The Defendant
15 then has a section entitled the "significance of the issues" where it talks about alleged prior
16 art, prior sales, concealment, and misrepresentation to the patent office. Defendant asserts
17 that the alleged prior sale would invalidate all of the claims under 35 U.S.C. § 102(b) if the
18 claims are construed as not having an upper size limit. The Court recognizes that the validity
19 of the patent and truth to such allegations are irrelevant at this stage of the litigation.

20 III. Discussion

21 A. Legal Standard

22 Established rules of claim interpretation require that the Court first consider the words
23 of the claims themselves, "both asserted and unasserted to define the scope of the patented
24 invention." Virtronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996).
25 The words are generally given their customary and ordinary meaning. *Id.* The Court will
26 follow the definition of terms intended by the patentee if his or her special definition is
27 clearly delineated in the specification or file history. *Id.*

28 Second, the Court considers the specification to determine whether the inventor has

1 employed any terms or words in a manner that is inconsistent with their plain and ordinary
2 meaning. Id. Indeed, "it is equally 'fundamental that claims are to be construed in light of
3 the specifications and both are to be read with a view to ascertaining the invention.' " Bell
4 Communications Research, Inc. v. Vitalink Communications, Corp., 55 F.3d 615, 620 (Fed.
5 Cir. 1995) (quoting United States v. Adams, 383 U.S. 39 (1966)). Third, the Court may
6 review the prosecution history of the patent. Id. This history is "the complete record of all
7 the proceedings before the Patent and Trademark Office, including any express
8 representations made by the applicant regarding the scope of the claims. As such the record
9 before the Patent and Trademark office is often of critical significance in determining the
10 meaning of the claims." Id. The Court may also examine prior art that is referenced in the
11 file history to obtain a general idea of what the claims do not cover. Id. at 1583.

12 These basic rules of construction also apply when courts consider the meaning of the
13 terms in a preamble. Bell, 55 F.3d at 620. Generally preambles will not limit the scope of
14 the claim when it merely states a purpose or intended use of the invention. In re Paulsen, 30
15 F.3d 1475, 1479 (Fed. Cir. 1994). However, the terms may provide specific limitations when
16 they give meaning to the claim and define the invention. Id. (quoting Gerber Garment
17 Technology, Inc. v. Lectra Systems, Inc., 916 F.2d 683, 688 (Fed. Cir. 1990)). A principal,
18 "as well-settled as any in our patent law precedent, is a claim preamble has the import that
19 the claim as a whole suggests for it. In other words, when the claim drafter chose to use both
20 the preamble and the body to define the subject matter of the claimed invention, the invention
21 is so defined, and not some other, is the one the patent protects." Id. (citations omitted).

22 Words of the preamble may give "life and meaning" and provide further positive
23 limitations on the invention claimed. Id. (citations omitted). A preamble further limits the
24 claim if such is "necessary to give meaning to the claim[s] and properly define the
25 invention." In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992); see also Diversitech Corp. v.
26 Century Steps, Inc., 850 F.2d 675, 678 (Fed. Cir. 1988) (language in the preamble limits the
27 claim if the "language is essential to particularly point out the invention defined by the
28 claims."). It has long been established that whether a preamble of intended purpose

1 constitutes a limitation to the claim is a matter to be determined on the facts of each case in
2 view of the claimed invention as a whole. In re Stencel, 828 F.2d 683, 751, 754 (Fed. Cir.
3 1987). "The effect preamble language should be given can be resolved only on review of
4 the entirety of the patent to gain an understanding of what the inventors actually invented and
5 intended to encompass by the claim." Corning Glass Works v. Sumitomo Elec., 868 F.2d
6 1251, 1256 (Fed. Cir. 1989).

7 **B. The Preambles Limit the Patent to a Sheet of Plastic used as Cutting Mat for Food**

8 In the instant case the Defendant argues that the phrase, "for cutting and handling
9 articles" and "flexible cutting sheet for food preparation comprising" does not set forth or
10 require any specific structural limitations and is merely a statement of intended use that
11 cannot be accorded any patentable weight. This Court disagrees. While the plain language
12 in claim one and six read in isolation may support the defendant's assertion, "it is legal error
13 to construe a claim by considering it in isolation. A claim must be read in view of the
14 specification of which it is a part." Bell, 55 F.3d at 621 (citations omitted).

15 The specification of the '790 patent makes it clear that the inventor was working on
16 the particular problems of kitchen cutting boards and not general improvements on sheets of
17 plastic. Such a conclusion is further supported by the prosecution history of the patent, and
18 finally by the interrelationship of the claims themselves. As a result, the introductory
19 preambles are more than mere statements of purpose because the language is "essential to
20 particularly point out the invention defined by the claim." In re Bulloch and Kim, 203
21 U.S.P.Q. 171, 174 (C.C.P.A. 1979). In short, to construe the claims as covering sheets of
22 plastic with a particular thickness and hardness, "would be divorced from reality." Corning
23 Glass Works, 868 F.2d at 1257. As did the Federal Circuit in Bulloch and Corning this Court
24 will review the patent in its entirety to gain an understanding of what the inventor actually
25 invented and intended to encompass by the claims. Corning, 868 F.2d at 1256 ("The effect
26 preamble language should be given can be resolved only on review of the entirety of the
27 patent to gain an understanding of what the inventors actually invented and intended to
28 encompass by the claim.").

1 **1. The Patent In Its Entirety**

2 **(a) The Specification**

3 The Defendant argues that the Specification does not provide clear support for the
4 Plaintiff's proposed claim interpretation because the words "cutting board" and "cutting mat"
5 do not appear in the detailed description, rather the claim refers to the term, "sheet." (Def.'s
6 Mem. at 13). Defendant admits that in the summary of the invention the words "cutting
7 board" do appear but such terms were added after the CIP was filed. Second, the Defendant
8 argues that the abstract does not specifically limit the invention to a cutting board and lends
9 one to "reasonably infer that the invention is a piece of extruded sheet plastic having certain
10 characteristics which make it useful both for cutting and for transporting articles, not that a
11 new use of an old sheet as a cutting board has been invented." (Def.'s Mem. at 14). Both of
12 Defendant's arguments are unavailing.

13 Taking the later argument first, as Plaintiff explains in its reply, an elementary point of
14 patent law is that the abstract of a patent has no legal effect. As denoted in Title 37 of the
15 Code of Federal Regulations, "[t]he purpose of the abstract is to enable the PTO and the
16 public generally to determine quickly from a cursory inspection the nature and gist of the
17 technical discourse. The abstract shall not be used for interpreting the scope of the claims."
18 37 C.F.R. § 1.72(b).

19 Second, Defendant's focus on the words "cutting board" and when they appeared
20 ignores the numerous examples in the specification history which indicate that the invention
21 is specific to plastic with certain characteristics used as a cutting and transfer board for food.
22 First, the title of the specification section is "Preparation and Transfer Sheet" which indicates
23 that the invention is not simply one of plastic with certain qualities, but plastic with certain
24 qualities used for the limited purpose of preparation and transfer. The Background of the
25 invention describes the various types of cutting boards previously used, as well as a litany of
26 their limitations such as: 1) The difficulty with cleaning, 2) their failure to serve as a funnel,
27 3) the lack of strength and, 4) the problem with boards curling. (Compl. Ex A, col. 1). Such
28 a detailed history of the problems with cutting surfaces in a typical household kitchen lends

1 support the conclusion that the invention is limited to plastic with certain qualities used for a
2 limited purpose.

3 Third, as explained in the summary of the invention, the novelty of the product is the
4 fact that it overcomes the problems of prior cutting boards because it has the ability to: 1) lay
5 flat, 2) resist perforation and spalling, 3) support food, 4) flex for transportation, 5) be
6 transparent to allow for recipes to be placed underneath, and 6) withstand the heat of a
7 dishwasher. (Compl. Ex. A, Col. 2 : 45-65). This comparison and highlight of the product's
8 characteristics further supports the conclusion that the claims are limited to a sheet used as a
9 cutting and transportation board for food.

10 Fourth, the figures and detailed description illustrate cutting a piece of celery,
11 handling a piece of chicken by holding the sheet in the flexed position, and using a knife
12 without completely penetrating the sheet. The drawings are specifically directed to the
13 cutting and handling of food.

14 Fifth the invention is summarized as,

15 a sheet of amorphous polypropylene co-polymer cut to a size suitable for food
16 preparation or other article handling. The thickness of the sheet and the
17 characteristics of the polypropylene allows a user to flex the board into a
18 cantilever or funnel shape so that articles can be lifted and transported on the
19 board. In addition, unlike cutting boards from formed roll stock, the extruded
cutting board of the present invention tends to lay flat rather than reassume a
curved configuration.

(Complaint, Ex. A, Col. 2: 10-20).

20 Admittedly, in this summary Plaintiff states that the sheet is suitable for food preparation or
21 other article handling. But, given the contents of the background section, the later reference
22 in the summary of the invention to the fact that the finish of the sheet results in a surface that
23 does not retain food material after cleaning, and the fact that all of the pictures that
24 accompany the patent relate to the preparation of food, it appears that the patent is limited to
25 using the material for preparing and transferring food. Indeed, as the Plaintiff states,
26 "[e]verything in the specification is directed to the cutting and handling of food if the
27 inventor had viewed the invention more broadly than a flexible cutting and handling sheet, at
28 least some other use for the sheet would have been suggested somewhere in the '790 patent."

1 (Pl.'s Mem. at 4). Moreover, there is no representation in the specification that the inventor
2 created the plastic sheet material himself. The patent states that "[a] type of polypropylene
3 having the above-described physical properties is manufactured by REXENE RESINS
4 Polypropylene 9231." (Compl. Ex. A, Col. 4: 2-5).

5 Accordingly, the specification supports Plaintiff's interpretation that the preambles in
6 claims one and six limits the patent to a sheet with specific characteristics used as a cutting
7 and transfer board for food.

8 **(b) Prosecution History**

9 The Defendant cites to statements made by the examiner, Plaintiff's attorney, and the
10 inventor to argue that the prosecution history supports a conclusion that the invention is a
11 flexible sheet and not a cutting board. Similarly, Plaintiff cites to statements by the
12 examiner, Plaintiff's attorney and the inventor. Moreover, Plaintiff relies on references to
13 prior art used by the examiner, and a declaration submitted by the Plaintiff during the
14 application process to argue that the scope of the invention is a cutting board made of a
15 flexible sheet of plastic.

16 **#1 Statements Made by the Examiner**

17 First, Defendant cites to the first office action issued by the U.S. Patent and
18 Trademark Office in which the examiner made a restriction requirement on the pending
19 claims. In so doing the examiner characterized Claims 1-5 and 9-11 as "drawn to a flexible
20 sheet, classified in Class 428, subclass 15." (Def.'s Mem., Ex. 6 at 28-35). The Defendant
21 claims that per the regulations of the patent office Class 428 does not cover cutting boards.

22 Plaintiff responds that the PTO classification system exists for the convenience of
23 parties searching the PTO's vast collection of issued patents, and states that Defendant cites
24 to no case authority holding that the classification of a particular patent carries any weight
25 whatsoever in interpreting claims in litigation. Indeed, as Plaintiff also indicates the use of
26 the PTO's classification system as evidence of the character of an invention has been viewed
27 cautiously in other contexts. See, e.g., In re Ellis, 476 F.2d 1370, 1372, 177 U.S.P.Q. 526,
28 527 (C.C.P.A. 1973) (holding that the classification of a patent carried far less weight than

1 the structure and function of the invention disclosed in the references). Additionally,
2 Plaintiff asserts that the PTO's classifications are not surprising. Plaintiff explains that class
3 428, subclass 500 refers to polymer "Nonstructural laminate." The patent-in-suit makes it
4 clear that the specific type of plastic material and not just any plastic is an important part of
5 the invention. The other important facet of the invention is the plastic sheet is in the form of
6 a cutting mat. "Either facet viewed independently of the other, is unremarkable. The
7 invention lies in the combination of these two facets." (Pl.'s Reply at 6). Thus, Plaintiff
8 concludes that the PTO's classification may reflect a belief that the patent is best classified as
9 a 'Nonstructural laminate' that contains polymer. "In view of the technical manner in which
10 the claims describe the plastic material itself, the PTO's classification is not surprising."
11 (Pl.'s Reply at 7).

12 Additionally, Plaintiff argues that the examiner's reference to prior art indicated that
13 he understood the invention was a flexible article cutting and handling sheet, and not merely
14 a sheet of plastic. Plaintiff explains that 35 U.S.C. §§ 102 & 103 of the Patent statute are the
15 two primary criteria under which PTO examiners assess the patentability of claims. Under
16 § 102(a) and (b) an article cannot be patented if it was known in the prior art. Section 103
17 prohibits articles from receiving a patent even if they were not known in the prior art, if the
18 differences between the article and the prior art as a whole would have been obvious to a
19 person of ordinary skill in the art. "In the beginning of the patent process the examiner
20 rejected the claims under 103 as being unpatentable over prior flexible cutting board known
21 as the Counter Maid ("Document AR") holding that the invention was unobvious in view of
22 the Counter Maid and the Encyclopedia of polymer Science and Technology." (Pl.'s Mem.,
23 Ex. A at 42). The examiner explained that a person skilled in the ordinary art familiar with
24 both the Counter Maid and the Encyclopedia entry for polypropylene would find the claimed
25 invention obvious. The examiner stated with reference to document AR that,

26 [t]he informational brochure teaches the use of flexible, reusable kitchen
27 boards that can be used as cutting boards. It would have been obvious to one
28 of ordinary skill in the art in an effort to develop a cutting board with properties
that were superior to that of wood boards to have combined the teaching of
using flexible kitchen [cutting boards] with the disclosure of the known
properties of polypropylene.

1 (Pl's Mem., Ex. A at 48).

2 The Plaintiff persuasively explains that had the examiner taken the position that the
3 invention was a mere piece of plastic and not a flexible cutting and handling sheet, he would
4 not have cited the Counter Maid reference and rejected the patent on such grounds.

5 **#2 Statements Made by Plaintiff's Counsel**

6 Second, Defendant cites to various statements made by Plaintiff's attorney to suggest
7 that the invention is not a cutting board, but a flexible sheet that can be used as a cutting
8 board. Defendant begins by discussing the Plaintiff's attorney response to the Patent
9 Office's stated action. The Plaintiff's attorney stated that Claim 1 defined a plastic sheet
10 material with specific characteristics and that, "[t]he selection of the specific characteristics
11 from available materials enables the applicant to achieve the benefits described for the
12 invention." (Def's Mem., Ex 8 at 41). Defendant's position is that this statement suggests
13 that the invention is a plastic sheet material with specific characteristics which has the benefit
14 of functioning as a cutting board.

15 Defendant then cites to the Preliminary Amendment filed in the CIP application where
16 the Plaintiff's attorney stated that, "[t]he claims of the present application are directed to a
17 thin sheet of material on which food can be cut and with which food can be transferred"
18 (Def.'s Mem., Ex. 7 at 37). Plaintiff's attorney describes properties of the sheets and states
19 that "[t]hese properties are generally considered mutually exclusive because hard sheets
20 cannot achieve the flexibility that render Applicant's invention suitable for use as a food
21 transfer scoop, and flexible sheets cannot achieve the properties that render Applicant's
22 invention suitable for use as a cutting board." Id. Defendant concludes that such statements
23 suggest that the invention was considered a sheet with certain unique characteristics which
24 allowed it to be effectively used as a cutting and transfer board and not a per se novel cutting
25 board.

26 However, reading the entirety of the statement, the position taken by counsel supports
27 Plaintiff's present position. First, in the caption, the preliminary amendment was designated
28 for a "Preparation and Transfer Sheet" (Pl.'s Mem., Ex. A at 93). Plaintiff's counsel begins

1 by stating that, "[t]he claims of the present application are directed to a thin sheet of material
2 on which food can be cut and with which the cut food can then be transferred by bending the
3 sheet into an arcuate trough." (Pl.'s Mem., Ex. A at 94). Plaintiff goes on to state that, "[a]s
4 evidenced by the Rule 132 Declaration submitted herewith, persons of skill in the art are
5 surprised by the resulting combination of sufficient hardness of the sheet to function as a
6 cutting board and sufficiently flexibility of the sheet to function as a food transfer scoop."
7 (Pl.'s Mem., Ex. A at 94).

8 Plaintiff makes additional references to this document to support its position. For
9 example, Plaintiff's attorney also stated that, "[i]n view of the specific combinations of
10 limitations recited in the claims, the above-quoted language from the encyclopedia of
11 Polymer Science and technology tells a person of ordinary skill in the art nothing about how
12 to create the claimed flexible food preparation board." (Pl.'s Mem., Ex. A at 96). Plaintiff's
13 attorney goes on to state that "[n]either the Encyclopedia of Polymer Science and
14 Technology nor any other reference would motivate a person of ordinary skill in the art to
15 substitute extruded polypropylene in the shape and thickness claimed by Plaintiff for the
16 material used in prior art flexible cutting boards." (Pl.'s Mem., Ex. A at 96-97). Hence the
17 statement in fact supports Plaintiff's interpretation of the claims.

18 #3 Declarations by the Inventor and Others

19 Third, Defendant states that the declaration of the inventor Rod Thompson, suggests
20 that he was the one who first conceived of the idea of a sheet of very thin extruded
21 polypropylene, such that its logical to conclude that the invention was a sheet of plastic with
22 particular characteristics. Mr. Thompson stated that:

23 I finally realized in approximately June of 1990 that an extruded sheet of
24 polypropylene, preferable about .010 inches in thickness, but in the range of
25 .008 to .060 inches would have the properties and advantages I desired. (I
26 discovered that extrusion is a process that would produce the lay-flat
27 characteristics.) When I asked plastics suppliers whether they could provide
28 such extruded sheet polypropylene in this thickness range, however, almost all
of them told me that they could only provide it from roll-stock. In
approximately September of 1991, I finally located a plastics supplier, Witt
Plastics of Greenville, Ohio, that could extrude sheet polypropylene to meet the
specification described above. I then instructed Witt Plastics to produce the
polypropylene sheets for me
(Pl.'s Mem., Ex. A at 99).

1 Plaintiff explains that by this Declaration the Inventor admitted that he did not invent
2 the plastic material himself, rather identified a commercial source of a suitable plastic.
3 Additionally, the Court notes that the Defendant failed to cite the beginning of his declaration
4 that supports the conclusion that the invention was not a thin plastic sheet but a cutting board.
5 Mr. Thompson begins his declaration by stating that,

6 I conceived of the invention in approximately June of 1990. Prior to that time I
7 had recognized the need for a plastic food preparation board that was
8 sufficiently thin and flexible to bend into a curved scoop for transferring food,
9 that would resist scoring by a knife, that would resist spalling and unsightly
10 blushing, and that would not have a tendency to curl, i.e., would have "lay flat"
11 characteristics. I further recognized the advantage of transparency to enable
12 recipes to be read through the board. Nevertheless, although I worked in the
13 plastics manufacturing industry, I did not know of a material that would satisfy
14 these requirements."
15 (Pl.'s Mem., Ex. A at 98).

16 Plaintiff also cites to a declaration that was submitted in the CIP application. This
17 declaration was prepared by Robert J. Casola, Jr., a person skilled in the plastic field. In this
18 declaration Mr. Casola stated that "[t]he best plastic for use for forming a sheet that can be
19 flexed to support food and yet is resistant to severe scoring by knives would not be obvious
20 to most people in the plastics industry." (Pl.'s Mem., Ex. A at 102). He goes on to state that,
21 "[i]t would not occur to most people in the plastics field to use a flexible yet hard plastic to
22 make a cutting board. Rather, to avoid scoring by a knife, those in the plastic field would
23 more likely have thought to use a sheet much thicker than .060 inches." (Pl.'s Mem., Ex. A at
24 103). This declaration focused on the issue of why it would not be obvious to those in the
25 plastics industry to use sheet material having the properties recited in the claims to form a
26 cutting board.

27 2. Analysis

28 After reviewing the patent in its entirety it is apparent to this Court that the inventor
attempted to address the particular problem of an effective cutting board made from plastic,
and not general improvements on plastic. To read the claims in light of the specification and
prosecution history to indiscriminately cover all types of plastic sheets would be divorced
from reality. Coming Glass Works, 868 F.2d at 1257. Accordingly, this Court finds that the

1 preambles in claims one and six are "more than a mere statement of purpose; and that
2 language is essential to particularly point out the invention defined by the claim." In re
3 Bulloch and Kim, 203 U.S.P.Q. 171, 174 (Fed. Cir. 1979).

4 In Bulloch, the applicant appealed a decision of the Patent and Trademark Office
5 Board of Appeals which rejected a patent application. The invention related to concentrates
6 (aqueous solutions) for developing photographic color film. The preamble of the proposed
7 patent stated, "A stable color developer concentrate essentially consisting of" Id. at 171.
8 The Applicant acknowledged that the invention was not in the creation of the alcoholates,
9 rather the use of these alcoholates as a concentrate, the concentrate being their claimed
10 invention. Id. at 174. The Federal Circuit noted that the claims were not drafted in the usual
11 form of use or method claims, but they viewed the reference to concentrate to limit the
12 claims to stable color developers. The court reasoned that the introductory claim language
13 "stable color developer concentrate" was more than a mere statement of purpose, but was
14 essential to point out the invention defined in the claims. The court went on to explain that in
15 light of the specification and the declarations there was no doubt that the intent of the
16 applicant was to limit the claims to color developer concentrates. Id.

17 This case is similar. As the Plaintiff in Bulloch, acknowledged that the invention was
18 not in the creation of alcoholates but in the use of these alcoholates as a concentrate; in this
19 case, as illustrated by the prosecution history and the invention, the patentee acknowledged
20 that the invention was not in the creation of the plastic but the use of plastic with specific
21 properties to create a flexible cutting board. Moreover, as in Bulloch, the specification
22 history leaves little doubt in this Court's mind that the intent of the inventor was to limit the
23 claims to a cutting and preparation board. Thus, the introductory claim language, "a flexible
24 sheet for cutting and handling articles thereon " and "a flexible cutting sheet for food
25 preparation" are more than statements of purpose. The preambles are essential to point out
26 the nature of the invention defined in the claims.

27 In Corning Glass Works, an alleged infringer attacked the validity of the claims saying
28 they were anticipated by prior art. The question of anticipation turned on claim

1 interpretation, particularly the effect of the preamble on the scope of the patent. 868 F.2d at
2 1255. The invention related to optical waveguide fibers of the type that are now widely
3 used for telecommunications, such as long distance telephone transmissions. The fibers were
4 developed as a transparent medium for guiding light of a laser a distance suitable for optical
5 communications. Id. at 1251. The dispute was whether the preamble stating "An optical
6 waveguide comprising" was a statement of intended use and purpose or constituted a
7 limitation of the invention. The Defendant believed that the words "optical waveguide"
8 should be ignored because it merely stated a purpose, meaning that the patent covered all
9 types of optical fibers even those that did not function as a waveguide as defined in the
10 specification. The Plaintiff argued that the specification set forth in detail the complex
11 equation for the structural dimensions and refractive index differential necessary to guide
12 light.

13 The court explained that the effect of the preamble language had to be resolved only
14 after a "review of the entirety of the patent to gain an understanding of what the inventors
15 actually invented and intended to encompass by the claim." The court explained that the
16 specification made clear that the inventors were working on the particular problem of
17 effective optical communication system and not on general improvements in conventional
18 optical fibers. "To read the claim in light of the specification indiscriminately to cover all
19 types of optical fibers would be divorced from reality." 868 F.3d at 1256. The court found
20 that the invention was restricted to fibers that worked as waveguides as defined in the
21 specification, "which is not true with respect to fibers constructed with the limitations of
22 paragraphs (a) and (b) only. Thus we conclude that the claim preamble in this instance does
23 not merely state a purpose or intended use for the claimed structure." Id. (citations omitted).
24 The court explained that the limitations outlined in paragraphs (a) and (b) of the first claim
25 were not the only limitations to the claim, because the claims required the additional
26 structural relationship defined in the specification for the core and the cladding to function as
27 an optical waveguide. Id.

28 Admittedly, the language in the current case is distinguishable, as the preamble in

1 claim one states a flexible sheet for cutting and handling, and the preamble in claim three
2 states a flexible cutting sheet for food preparation. While the word "for" in claims one and
3 six more strongly imply that the preambles are a mere statement of intended use, the
4 principals underlying Corning dictate a different result. As in Corning, in the instant case the
5 focus of the inventor was narrow and well defined in the specification history. The point of
6 the invention is to address problems in the current state of cutting mats. The preamble is
7 "necessary to give meaning to the claim[s] and properly define the invention." In re Fritch,
8 1260, 1262 (Fed. Cir. 1992). The terms cutting and handling is a necessary limitation
9 because it breathes life and meaning into the claims. Loctite Corp., 781 F.3d at 866.

10 As Plaintiff points out, the limitations in the claims relate to the terms "cutting" and
11 "handling" and reveal how these terms are a necessary limitation. For example, claim one
12 defines the appropriate cantilever beam strength. This terminology refers to the weight that
13 the sheet will support without bending to such an extent that the article is dropped. This
14 reference has little meaning divorced from the limitation that the claimed invention is not a
15 mere sheet of plastic, but a sheet for transporting articles. Additionally, the claim limits the
16 sheet to one that has "lay-flat characteristics." As explained in the specification this
17 characteristic is essential for a cutting board. Thus, the limitation is further evidence that the
18 invention has the inherent function of serving as a cutting mat, otherwise there would be no
19 need for it to lay flat on the counter top. Therefore, in light of the principles delineated in
20 Corning and In re Bulloch this Court finds that the preambles in claims one and six limits the
21 claims to a preparation and transfer sheet for food.

22
23 **B. An Upper Size Limit is Implicit from the Preamble Language in Claims One**
24 **and Six.**

25 The second claim interpretation issue is whether the preambles in claims one and six
26 should be read on the remaining claims to limit the maximum size of the sheet to one typical
27 of a cutting board, which allows a person to hold the sheet in the flexed or cantilever position
28 and support articles thereon. The general rules of claim construction and preambles

1 discussed above applies equally to this analysis.

2 Plaintiff readily admits that neither the preambles nor the claims explicitly recite the
3 maximum dimensions that characterizes the sheets. (Pl.'s Mem. at 16). Plaintiff contends,
4 however, that it is proper under "the holdings of *Rowe* and other cases" to read the claims as
5 limiting the maximum size of the sheet to one that is typical of a cutting board. Plaintiff
6 asserts that because in the Specification it is explained that the sheet is "cut to a size suitable
7 for food preparation or other article handling, there is clearly an upper size limit at which no
8 person would reasonably identify a plastic sheet as a cutting mat that could be held and
9 flexed into a trough." (Pl.'s Mem. at 16). Plaintiff argues that the recitations in the
10 preambles of claim 1 of the "cutting" and "handling" function and in claim 6 of the "cutting"
11 and "flexible" limitation precludes the claims from reading on large industrial sheets of
12 plastic that could never be held in a user's hand and flexed, and used to transfer food in the
13 manner described in the patent. Plaintiff offers that a logical upper bound would be 11
14 inches by 15 inches, the size of the cutting mat illustrated in the patent. Finally, Plaintiff
15 explains that if possible a claim should be construed to sustain their validity. Accordingly,
16 Plaintiff argues that validity considerations favor Plaintiff's interpretation of the claims as not
17 reading on large industrial-size sheets of plastic that would be too large to use as a funnel to
18 transfer food in the manner described in the patent.

19 Defendant argues that the concept of an upper size limit is not addressed in the claims
20 because by their terms the claims do not limit the upper size of the sheet, i.e the sheet has, "a
21 width greater than 6 inches and a length greater than 10 inches" (Claim 1), and " a first
22 dimension in excess of 6 inches and a second dimension traverse to said first dimension, in
23 excess of 10 inches" (Claim 7 Dependent on Claim 6). Defendant also argues that the
24 specification does not address the concept of an upper size limit. Finally, Defendant argues
25 that Plaintiff intended to claim a sheet having no specified upper size limit as evidence by its
26 Amendment A filed on November 19, 1993. In this Amendment Plaintiff's counsel stated
27 that:

28 Applicant points out that so long as the material corresponds to the thickness
and parameters set forth in the claims, (sic) the sheet may be of virtually any

1 size and be useful for transfer of food articles and the like where the food
2 article is not supported over a distance greater than that specified. For
3 example, even a 2 foot by 3 foot section of material could be utilized as
4 described so long as the funneling action was caused to take place no greater
5 than 10" from the proximate end.
(Def.'s Mem. Ex. 8 at 41).

6 Perhaps notably Plaintiff did not respond to Defendant's citation to such statements made in
7 the Amendment.

8 The Court is troubled by the fact that Plaintiff contends that its argument is supported
9 by "Rowe and other case" what other cases there are to which Plaintiff refers the Court does
10 not know. Moreover, how Rowe specifically supports its position is also not particularly
11 clear to the Court, because Rowe did not discuss reading size limitations into claims that are
12 written with no specified limitations. Plus, the fact that in its Amendment Plaintiff
13 specifically pointed out to the examiner that the sheet could be virtually of any size is
14 somewhat troublesome.

15 On the other hand, to determine whether the preambles limit the size of the invention
16 the Court must look to the entire patent record to determine what invention the patentee
17 intended to define and protect. Bell Communications, 55 F.3d at 621. As discussed
18 extensively above the Specification history clearly indicates that the patentee intended to
19 protect a cutting board that could also be used to transfer food into a container. Thus, it
20 logically follows that the invention must be limited to a size reasonable for such use. In fact,
21 as Plaintiff indicates the Specification specifically states that the sheet is "cut to a size
22 suitable for food preparation or other article handling." (Pl.'s Mem., Ex. A at 32). Moreover,
23 the patentee provides illustrations of the invention and includes lengths and widths. The
24 length and width are also specifically given in the detailed description of the drawings in
25 which the patentee explains, "[a]s illustrated the sheet has a width of approximately 11 inches
26 and a length of approximately 15 inches. Therefore, the weight of the chicken or other food
27 article is supported on a cantilever beam support formed by the flexion of the sheets." (Pl.'s
28 Mem., Ex. A at 33).

Thus, it would be divorced from reality to assume that the invention has no upper size

1 limit because by its definition the invention requires that a person be able to handle the article
2 and flex it into a trough. In light of such intention it is reasonable to conclude that the terms
3 "handling" and "flexible" limit the article to a size that a person could hold and flex into a
4 trough like shape to transfer food into a bowl. Moreover, in light of the specific lengths and
5 widths given in the illustrations and detailed description of the drawings, this Court
6 concludes that the preambles in claims one and six limit the invention to one that is eleven
7 inches by fifteen inches.

8 The Court does not believe that this conclusion is undermined by Plaintiff's counsel's
9 statements in the Amendment, cited by the Defendant in its Reply. Given the context in
10 which Plaintiff said the sheet could have any upper size limit it does not evidence the intent
11 to leave the size indefinitely open as Defendant contends. Specifically, Plaintiff said "the
12 sheet may be of virtually any size and be useful for transfer of food articles" it may be
13 implicit in the statement "virtually any size" that it must nonetheless be one that is
14 manageable by someone trying to cut and transfer food. Alternatively, the example of a two
15 foot by three foot section of material may represent the outer most limit in which the material
16 could be flexed to cause the funneling action; even though, it fails to take into account the
17 ease of handling the object which is implied by the words in the specification, "cut to a size
18 suitable for food preparation," and implied by the appearance of the word "handling" in the
19 actual claim language. Hence, this Court concludes that the preambles of claims one and six
20 read into the remaining claims a maximum size of the sheet to one that has an approximate
21 width of eleven inches and an approximate length of fifteen inches.

22 //

23 //

1 IV. Conclusion

2 For the reasons set forth above this Court finds that the preambles in claims one and
3 six limit the scope of the claims to a sheet of plastic used as a cutting and transferring board
4 for food, as distinguished from a simple plain sheet of plastic. Additionally, this Court finds
5 that the preambles in claims one and six define the sheet of plastic used as a cutting and
6 transferring board for food with an upper size limit of eleven inches in width and fifteen
7 inches in length.

8 IT IS SO ORDERED.

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10 DATED: April 23, 1998


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NAPOLEON A. JONES, JR.
United States District Judge

cc: All Parties